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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,772	09/08/1999	WALTER V. DIXON III	RD-27.422	9058
7590	01/11/2005		EXAMINER	
JOHN S BEULICK ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST LOUIS, MO 631022740			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/391,772	DIXON ET AL.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 September 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 5-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2 and 5-21 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1, 2, and 5-21 are pending. Claims 3 and 4 have been canceled and claims 19-21 have been newly added in this communication filed 09/21/04 entered as Response to Non-Final Rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 8, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites "... determining whether segmentation of the undefined format report is needed, segmentation includes identifying a location of data within the undefined format report and relocating data within the undefined format report such that the document is recognizable;". The metes and bounds of this claim limitation as amended cannot be determined because the claim limitation as written is very confusing and unclear. Claims 8 and 17 have a similar problem. Further, it is not understood from Applicants' claim language, drawings, or specification what Applicants' mean by "undefined format".

Specification

4. The amendment filed 09/21/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows: the amended claim limitations claims 1, 6- 8,11, 15, and 19-21 including “an undefined format”.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8, 9, 11, 12, 14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,608,874) Ogawa et al, hereafter Ogawa.

With respect to claim 1, Ogawa teaches, generating at the accounting system a report having at least one of a defined report format and a defined translation service, and an undefined format (col. 8, lines 35-38 and lines 51-63 and col. 9, lines 1-6, lines 12-22, lines 34-36, and lines 45-50); exporting the report from the accounting system to a local file system (col. 8, lines 51-60 and col. 19, lines 1-6); submitting the report from the local file system to the server (col. 28, lines 13-28, fig. 3(21 & 30), fig. 4 (170 & 160), and fig. 10 (720)); determining at the server whether the submitted report has the at least one of the defined report format and the defined translation service and the undefined format (col. 10, lines 18-42); and extracting via the server information from the report based on at least one of the defined report format and the defined translation service, and the undefined format to generate at least one exhibit to the report, the at least one exhibit summarizing selected information included in the report and linking the

summarized information included in the exhibit to corresponding information in the report (col. 28, lines 30-67). An accounting system by definition is the methods, procedures, & standards followed in accumulating, classifying, recording, & reporting business events & transactions. The accounting system includes the formal records & original source data. Regulatory requirements may exist on how a particular accounting system is to be maintained (e.g. insurance company).

With respect to claim 8, Ogawa further teaches, An automated lending system comprising an accounting system coupled to a local file system (col. 8, lines 60-63), and a server (col. 8, lines 22-28) for communicating with the local file system (col. 8, lines 44-50), said accounting system configured to generate a report having at least one of a defined report format and a defined translation service, and an undefined format (col. 8, lines 34-39). This independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 2, Ogawa teaches, submitting the report comprises attaching the report to a web form (col. 8, lines 15-27 and col. 10, lines 27-45).

With respect to claim 9, Ogawa teaches, the local file system is accessible by a browser (col. 18, lines 5-10).

With respect to claim 11, Ogawa teaches, wherein generating at the accounting system a report comprises generating at the accounting system a report including at least one electronic document having an undefined format (col. 14, lines 29-39 and col. 15, lines 5-33).

With respect to claim 12, Ogawa teaches, wherein extracting via the server information from the report further comprising utilizing the defined translation service at the server to extract information from the report and then generate at least one exhibit based on the extracted information (col. 9, lines 12-22).

With respect to claim 14, A method in accordance with claim 6 wherein extracting via the server information from the report further comprising the steps of: determining whether to utilize the defined translation service to extract information included in the report (col. 9, lines 38-43); utilizing at the server, if needed, the defined translation service to extract information included in the report and then generate the at least one exhibit based on the extracted (col. 10, lines 21-26).

This claim is also rejected for the similar rationale given above to claim 12.

With respect to claim 16, this claim is rejected for the similar rationale given above for claims 12 and 14.

With respect to claim 17, this independent claim is rejected for the similar rationale as given above for claims 1, 6, and 8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 7, 10, 13, 15, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa in view of (US 5,864,871) Kitain, hereafter Kitain .

With respect to claim 5, Ogawa did not teach, extracting information from the report using a print scraping process.

Kitain discloses, extracting information from the report using a print scraping process (col. 5, lines 28-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have extracting information from the report using a print scraping process and to modify in Ogawa because such a modification would allow Ogawa to have printable documents and a common viewing format such as, PDF format.

With respect to claim 7, Ogawa teaches, receiving at the server a report having an undefined format; determining whether preprocessing of the undefined format report is needed; determining whether segmentation of the undefined format report is needed, segmentation includes identifying a location of data within the undefined format report and relocating data within the undefined format report such that the document is recognizable; performing a document recognition process including scanning the undefined format report to determine a file type of the report and comparing the file type to a list of known file types stored in a data repository; performing a mapping and translation process on the undefined format report including selecting an extraction script based on the document recognition process for extracting and translation included in the report (col. 5, line 26 –col. 6, line 28 and fig. 1 (76A, 78A, 76B, 78C, and 76C)).

With respect to claim 10, Ogawa did not teach, wherein the local file system is accessible by a browser, and wherein submitting the report from the local file system to

the server further comprises submitting the report from the local file system to the server using the browser.

Kitain discloses, wherein the local file system is accessible by a browser, and wherein submitting the report from the local file system to the server further comprises submitting the report from the local file system to the server using the browser (col. 1, lines 61-67, col. 2, lines 1-14, col. 11, lines 43-54, col. 13, lines 18-37, col. 15, lines 59-67, col. 16, lines 1-8, and col. 33, lines 49-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the local file system is accessible by a browser, and wherein submitting the report from the local file system to the server further comprises submitting the report from the local file system to the server using the browser and to modify in Ogawa because such a modification would allow Ogawa to have browser programs executed by the user computer and the user is able to simply make a request to a remote server for the file.

With respect to claim 13, Ogawa teaches, wherein extracting information from the report using a print scraping process further comprises; determining whether preprocessing of the report is needed (col. 16, lines 49-53); performing a document recognition process including scanning the report to determine a file type of the report and comparing the file type to a list of known file types stored in a data repository (col. 22, lines 32-40); and performing a mapping and translation process on the report including selecting an extraction script based on the document recognition process for extracting and translating data from the report (col. 26, lines 1-19 and lines 42-63).

With respect to claim 15, this claim is rejected for the similar rationale given above for claim 13.

With respect to claim 18, this claim is rejected for the similar rationale given for claims 13 and 15.

With respect to claims 19, 20, and 21, these dependent claims are rejected for the similar rationale as given above for claim 7.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over(US 5,608,874) Ogawa et al, hereafter Ogawa in view of (US 6,266,150) Grossman et al, hereafter Grossman.

Ogawa substantially teaches all of the claim limitations of claim 6, except, transmitting the report from the accounting system to the server via the virtual printer.

Grossman discloses, transmitting the report from the accounting system to the server via the virtual printer (col. 3, lines 23-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the report from the accounting system to the server via the virtual printer and to modify in Ogawa because such a modification would allow Ogawa to have an information determination unit which determines whether another or at least one other device is

available to support a functional upgrade of the printer itself based upon the ability information which was transmitted from other devices connected to the network in response to the inquiry for the ability information, and determines its printer's own virtual printer information.

Response to Arguments

11. Applicant's arguments filed 09/21/04 are not considered persuasive. The Issues and arguments addressed here below are considered to be the Applicants' main arguments as the best that can be determined.

Issue no. 1: Applicants' argue: Applicants' respectfully submit that Ogawa does not describe nor suggest the claimed invention and Ogawa does not describe nor suggest a method that includes a server extracting information from a report based on at least one of a defined report format, a defined translation service, and an undefined format to" has been considered but are not persuasive. Response: Applicants' appear to be arguing the amendment to claims 1, 6, 8, and 17.

Issue no. 2: Applicants' argue: Ogawa does not describe nor suggest receiving at a server a report that includes an undefined format, determining whether preprocessing of the undefined format report is needed, determining whether segmentation of the undefined format report is needed wherein segmentation includes ..." has been considered but is not persuasive. Response: These claim limitations are not found in claims 1, 2, 8, 9, 11, 12, 14, 16, and 17. Therefore this argument is considered moot. Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Issue no. 3: Applicants' argue: Ogawa does not describe nor suggest a method that includes extracting via a server information from a report based on at least one of a defined report format, a defined translation service, and an undefined format " and notably, Ogawa does not teach generating an exhibit to a report by extracting information from the report and Applicants' respectfully submit that Ogawa does not teach extracting information from a report to generate at least one exhibit to the report wherein the at least one exhibit summarizes selected information included in the report and links the summarized information included in the exhibit to corresponding information in the report has been considered but is not persuasive. Response: Since Ogawa teaches extracting each field, it is inherent that each field contains information in a common format. Applicants' again appear to be arguing the amendments to claims 1, 6, 8, and 17.

Issue no. 4: Applicants' argue: Applicants' respectfully submit that Ogawa does not teach a server configured to extract information from a report to generate at least one exhibit relating to the report wherein the exhibit summarizes selected information ..." has been considered but is not persuasive. Response: It is interpreted that Ogawa teaches a server (Fax PrepServer) to extract information from a report to generate at least one exhibit relating to the report wherein the exhibit summarizes selected information ..." in col. 28, lines 30-67.

Issue no. 5: Applicants' argue: Ogawa does not describe nor suggest the method as recited in Claim 6 and more specifically, Ogawa does not describe nor suggest a method that includes transmitting a report from an accounting system to a server via a virtual printer, and extracting via the server information from the report to generate at least one exhibit to the report wherein the at least one exhibit summarizes selected information included in the report and links the summarized information included in the exhibit to corresponding information in the report has been considered but is not persuasive. Response: Ogawa was not used to reject the entire claim 6 limitations. Grossman was used to reject the claim limitation of a server and a virtual printer.

Issue no. 6: Applicants' argue: Ogawa does not describe nor suggest an automated lending system that includes an accounting system having a virtual printer, and a server for communicating with the accounting system, wherein the accounting system is configured to transmit a report to the server via the virtual printer, ..." has been considered but is not persuasive. Response: Ogawa teaches, a server, a printed statement (a report), data analysis, logical, statistical and mathematical operations (this could be interpreted as accounting) and Grossman teaches a virtual printer.

Issue no. 7: Applicants' argue: Applicants' respectfully submit that neither Ogawa nor Kitain, considered alone or in combination, describe or suggest the claimed invention has been considered but is not persuasive. Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kitain teaches, a local file system, extracting information from a report, and submitting the report from the local file system to the server via a browser and Ogawa teaches generating a report having at least one defined format and a defined translation service, exporting the report, and a server and performing the steps of the claim limitations over a network. It is interpreted that Kitain and Ogawa teach the rejected claim limitations as addressed above in this Office action and the previous Office action.

Issue no. 8: Applicants' argue: Kitain does not describe nor suggest determining whether preprocessing of a report is needed, determining whether segmentation of the report is needed ..." has been considered but is not persuasive. Response: The information has to be extracted from the report prior to printing and placed in a recognizable format for the printer to have the ability to print the document.

Issue no. 9: Applicants' argue: Ogawa nor Brossman, considered alone or in combination, describe or suggest a method that includes transmitting a report from an accounting system to a server via a virtual printer, and extracting via the server information from the report ... has been considered but is not persuasive. Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Grossman teaches a virtual printer that can be used in Ogawa for printing a report. The report being an accounting report is considered a field of use. Virtually any report goes through the same steps as those of Applicants' invention. The report has to be transmitted from whatever system is being used to a server prior to printing and the information has to be put in a recognizable format that is compatible with the printer being used to print the document(s).

Issue no. 10: Applicants' argue: Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Ogawa using the teachings of Kitain and Grossman has been considered but is not persuasive. Response: Rationale may be in a reference or reasoned from common knowledge in the art, scientific principles, art-recognized equivalents, or legal precedent". The reason or motivation to modify the reference may often suggest what the inventor has done but for a different purpose or to solve a different problem. It is not necessary to achieve the same advantage or result discovered by Applicants'. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)

(references do not have to explicitly suggest combining teachings); and *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning). MPEP 2144.

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in the Ogawa, Kitain, and Grossman references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).<

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' are respectfully requested to point out to the Examiner which claim limitation is considered to be the inventive concept because the inventive concept can not be determined from the claim limitations as written.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
January 8, 2005